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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,011	02/22/2002	Clifford H. Patridge	47097-0110USPT	1903
30223	7590	05/03/2004	EXAMINER	
JENKENS & GILCHRIST, P.C. 225 WEST WASHINGTON SUITE 2600 CHICAGO, IL 60606			PASCUA, JES F	
			ART UNIT	PAPER NUMBER
			3727	

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/082,011	<b>Applicant(s)</b> PATRIDGE ET AL.	
	<b>Examiner</b> Jes F. Pascua	<b>Art Unit</b> 3727	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 3-5, 16-29, 33-35 and 44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6-15, 30-32, 36-43, 45 and 46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/01/04 has been entered.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the combination of a polymeric bag and a trash can or container must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 6, 8, 30, 31, 36, 38, 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wan.

Wan discloses the claimed invention except for a trash can or container in combination with the garbage bag. It would have been an obvious matter of design choice to provide the garbage bag of Wan with a trash can or container, since applicant has not disclosed that combining a trash can or container with a garbage bag solves any stated problem or is for any particular purpose and it appears that the Wan invention would perform equally well in combination with a trash can or container.

Regarding the recitation "the second width adapted to be stretched over the bag engaging periphery of the trash can", it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Wan forms a bag width between seal 1 and the opposite bag side that is smaller than the width between the opposing bag sides. Therefore, the width between seal 1 and the opposing bag side is capable of being stretched over the bag engaging periphery of a trash can.

5. Claims 2 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wan.

Wan discloses the claimed invention except for the bag having a second narrowing seal. It would have been obvious to one having ordinary skill in the art at the

time the invention was made to provide the Wan bag with a second narrowing bag seal, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

6. Claims 10-13 and 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wan.

Wan discloses the claimed invention except for the first and second panels of the bag being formed made from a single, folded polymeric sheet or from two separate polymeric sheets. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the first and second panels of the Wan bag from a single, folded polymeric sheet or from two separate polymeric sheets since it was known in the bag art that a single, folded polymeric sheet or from two separate polymeric sheets may be utilized to form the first and second panels of a bag.

7. Claims 9 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wan.

Wan discloses the claimed invention except for the narrowing seal being formed by heat sealing the first and second panels instead of adhering the first and second panels. It would have been obvious to one having ordinary skill in the art at the time the invention was made to forming the narrowing seal of Wan by adhering the first and second panels since the Examiner takes Official Notice of the equivalence of adhesive seals and heat seals for their use in the bag art and the selection of any of these known

equivalents to form the narrowing seal of Wan would be within the level of ordinary skill in the art.

8. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable Wan.

Wan discloses the claimed invention except for the first width being about 24 inches and the second width being about 21 inches. It would have been an obvious matter of design choice to make the first width of Wan about 24 inches and to make the second width of Wan about 21 inches, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

9. Claims 7 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wan.

Wan discloses the claimed device, except for the narrowing seal being arcuate or triangular. It would have been an obvious matter of design choice to make the narrowing seal of Wan with an arcuate or triangular shape or whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.


***Response to Arguments***

10. Applicant's arguments with respect to claims 1, 2, 6-15, 30-32, 36-43, 45 and 46 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jes F. Pascua whose telephone number is 703-308-1153. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W. Young can be reached on 703-308-2572. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jes F. Pascua  
Primary Examiner  
Art Unit 3727

JFP